

## **REMARKS**

### **Status of Application**

Claims 1-30 and 33-41 are pending in the application; the status of the claims is as follows:

Claims 1 and 18 are rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to point out and claim the subject matter of the invention.

Claims 1-4, 6-10, 12, 13, 17, 19-21, 23-25, 28-30, 33, and 35-41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Application Publication No. 2003/0208434 to Posner ("Posner"), in view of U.S. Patent No. 6,330,542 B1 to Sevcik et al ("Sevcik").

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Posner in view of Sevcik, in further view of U.S. Patent No. 6,397,197 B1 to Gindlesperger ("Gindlesperger").

Claims 11, 22 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Posner in view of Sevcik, in further view of U.S. Patent No. 6,078,906 to Huberman ("Huberman").

Claims 14-16 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Posner in view of Sevcik, in further view of U.S. Patent No. 6,671,674 B1 to Anderson et al ("Anderson").

Claim 34 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sevcik in view of Posner.

### **Claim Amendments**

Claims 1, 21, 34, and 37 have been amended to more explicitly define the order of the steps of the methods claimed. These changes do not introduce any new matter.

Claim 33 has been amended to more explicitly define one of the steps of the claimed method. This change does not introduce any new matter.

**35 U.S.C. § 112 Rejection**

The rejection of claims 1 and 18 under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, is respectfully traversed based on the following.

The Office Action notes the following language of claim 1 is indefinite, “wherein said buyer may select one of said first and second printers.” In particular, the Examiner takes the position that the buyer may not select one of the first and second printers. The Applicants note that the Examiner is correct; the buyer may not always select one of the first and second printers. As an example, the buyer may have a budget of \$15K for a large printing project. The initial estimated prices are \$22K and \$20K for the first and second printers, respectively. After the printers contact the buyer and negotiate at least a portion of the specifications, the corresponding negotiated prices are now \$19K and \$17.5K for the first and second printers, respectively. Because both of these are more than the buyer’s budget, the buyer would not select either printer. The claim is for a method of determining a price for a print job; not the ultimate outcome. Thus, the Applicants assert the claim as written does particularly point out and distinctly claim the subject matter.

With respect to claim 18, the Examiner states she is unable to determine how the printers are shielded from the price if the printers provide a price list. As claimed in claim 17, both manufacturing and raw material components are calculated. The manufacturing component can include the labor, the wear and tear on the printing machines, and the consumed supplies, such as toner, etc. The raw material component covers the paper requirements. As the manufacturing component costs may be independent of the type of paper used, there would be no reason why the printer would need to know the cost of the raw material component. The Applicants wish to point out that it is only the raw material component, not the manufacturing component, of the final

estimated prices that is shielded from the printers. Because these two components are independent, shielding the printers from the raw material component is simple.

Accordingly, it is respectfully requested that the rejection of claims 1 and 18 under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, be reconsidered and withdrawn.

**35 U.S.C. § 103(a) Rejections**

The rejection of claims 1-4, 6-10, 12, 13, 17, 19-21, 23-25, 28-30, 33, and 35-41 under 35 U.S.C. § 103(a) as being unpatentable over Posner in view of Sevcik is respectfully traversed based on the following.

Claim 1 requires, in part:

- calculating a first estimated price for said print job with respect to a first printer based on pricing information provided by said first printer for each of said components thus specified;

- calculating a second estimated price for said print job with respect to a second printer based on pricing information provided by said second printer for each of said components thus specified;

- informing said buyer of at least a lower of said first and second estimated prices; and

- thereafter informing said first and second printers of said set of specifications and an identity of said buyer so as to allow at least one of said first and second printers to contact said buyer to negotiate at least a portion of said set of specifications, wherein said buyer may select one of said first and second printers based on a negotiated set of specifications and a corresponding negotiated price.

In summary, claim 1 requires calculating first and second estimated prices, informing the buyer of at least the lower of these estimated prices, and thereafter informing the printers of the set of specifications and the identity of the buyer.

In contrast, Posner's system includes a "broadcast module 114, which is configured to broadcast the requested data to a desired number of vendors," *see* paragraph [0023]. In other words, Posner broadcasts an RFP to many vendors, not just two, and does so before informing the buyer of at least the lower of two estimated prices as required by claim 1. That Posner broadcasts an RFP to many vendors that subsequently submit bids is evident in that the buyer must study the received bids and "determine a 'Short List' of vendor bids," *see* paragraph [0039]. Thus, it appears that much of the "weeding out" process of the present invention falls upon the buyer using Posner's system. Because Posner's system discloses that each vendor submit a bid in response to a broadcast RFP, it fails to disclose or suggest several limitations of claim 1. In particular, Posner does not disclose calculating first and second estimated prices, informing the buyer of at least the lower of the estimated prices, and thereafter informing the vendors of the set of specifications and identity of the buyer. In fact, Posner does not disclose or suggest calculating any estimated prices, and therefore cannot disclose or suggest informing a buyer of any calculated estimated prices. Lastly, Posner discloses informing the vendors of at least the set of specifications from the very beginning of the process, not after having calculated any estimated prices.

To overcome these significant shortcomings, the Office Action combines Sevcik with Posner. Sevcik appears to disclose calculating first and second estimated prices and informing the buyer of the lower of the estimated prices. However, the cited portions of Sevcik do not disclose or suggest informing the first and second vendors of the set of specifications and the identity of the buyer after calculating the estimated prices. In sum, neither the cited portions of Posner nor the cited portions of Sevcik disclose, "thereafter informing said first and second printers of said set of specifications and an identity of said buyer."

Does the combination of Posner and Sevcik disclose or suggest, "thereafter informing said first and second printers of said set of specifications and an identity of said buyer?" The cited portions of Sevcik do not disclose informing the first and second

vendors of the set of specifications and the identity of the buyer at all. Thus, any disclosure or suggestion regarding informing the vendors of the set of specifications and the identity of the buyer must come from Posner. However, Posner discloses informing the vendors of at least the set of specifications from the very beginning of the process, and thus cannot suggest informing the vendors of the set of specifications and the identity of the buyer only after calculating estimated prices. Therefore, the combination of Posner and Sevcik fails to disclose or suggest each limitation of claim 1 and therefore cannot render claim 1 obvious.

Claims 2-4, 6-10, 12, 13, 19, and 20 depend from claim 1. As claim 1 is nonobvious over the combination of Posner and Sevcik, claims 2-4, 6-10, 12, 13, 19, and 20 are nonobvious for at least the same reason.

Claim 21, similar to claim 1, requires calculating first and second price estimates, notifying the buyer of the lower of the price estimates, and thereafter providing at least one of the printers with the set of specifications and price estimate, thereby allowing the at least one printer to negotiate with the buyer. As discussed above, the combination of Posner and Sevcik fails to disclose or suggest all of these limitations and therefore cannot render obvious the invention of claim 21. Claims 23-25 and 28-30 depend from claim 21. As claim 21 is nonobvious over the combination of Posner and Sevcik, claims 23-25 and 28-30 are nonobvious for at least the same reason.

Claim 33 requires, in part:

estimating, based on said pricing model, a first price for said print job to be printed in accordance with said first set of specifications, thereafter providing said printer with said first set of specifications and an identity of said buyer, wherein said first set of specifications may be modified by negotiation between said buyer and said printer

In summary, claim 33 requires estimating a first price, and thereafter informing the printer of the first set of specifications and the identity of the buyer.

As discussed above, the combination of Posner and Sevcik fails to disclose or suggest estimating a first price, and thereafter informing the printer of the first set of specifications and the identity of the buyer and therefore cannot render obvious the invention of claim 33.

Claims 35 and 36 depend from claim 34. As discussed below, the combination of Posner and Sevcik fails to disclose each limitation of claim 34 and thus cannot render claim 34 obvious. As claim 34 is nonobvious over the combination of Posner and Sevcik, claims 35 and 36 are nonobvious for at least the same reason.

Claim 37 requires, in part:

- calculating an estimated price for said print job with respect to a printer based on pricing information provided by said printer for each of said components thus specified;
- informing said buyer of said estimated price; and
- thereafter informing said printer of said set of specifications and an identity of said buyer so as to allow said printer to contact said buyer to negotiate at least a portion of said set of specifications, wherein said buyer may select said printer to perform said print job based on a negotiated set of specifications and a corresponding negotiated price

In summary, claim 37 requires calculating an estimated price, informing the buyer of the estimated price, and thereafter informing the printer of the set of specifications and the identity of the buyer.

Claim 37, similar to claim 1, requires calculating an estimated price, informing the buyer of the estimated price, and thereafter informing the printer of the set of specifications and the identity of the buyer. As discussed above, the combination of Posner and Sevcik fails to disclose or suggest all of these limitations and therefore cannot render obvious the invention of claim 37. Claims 38-41 depend, either directly or indirectly, from claim 37. As claim 37 is nonobvious over the combination of Posner and Sevcik, claims 38-41 are nonobvious for at least the same reason.

Accordingly, it is respectfully requested that the rejection of claims 1-4, 6-10, 12, 13, 17, 19-21, 23-25, 28-30, 33, and 35-41 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

The rejection of claim 5 under 35 U.S.C. § 103(a), as being unpatentable over Posner in view of Sevcik, in further view of Gindlesperger, is respectfully traversed based on the following.

Claim 5 depends from claim 1. As shown above, the combination of Posner and Sevcik fails to disclose or suggest calculating first and second estimated prices, informing the buyer of at least the lower of these estimated prices, and thereafter informing the printers of the set of specifications and the identity of the buyer, and therefore fails to render claim 1 obvious. Claim 5 is likewise nonobvious over the combination of Posner and Sevcik for at least the same reason.

Forming the combination of Posner, Sevcik, and Gindlesperger similarly fails to disclose or suggest calculating first and second estimated prices, informing the buyer of at least the lower of these estimated prices, and thereafter informing the printers of the set of specifications and the identity of the buyer. The Office Action cites to a portion of Gindlesperger disclosing the generation of a buyer's invoice upon completion of the print job by the winning printer. As this is unrelated to calculating first and second estimated prices, informing the buyer of at least the lower of these estimated prices, and thereafter informing the printers of the set of specifications and the identity of the buyer, the cited portion of Gindlesperger fails to disclose or suggest this limitation of claim 1. In sum, the cited combination of Posner, Sevcik, and Gindlesperger fails to disclose or suggest all of the limitations of claim 1 and therefore cannot render claim 1 obvious. As claim 5 depends from nonobvious claim 1, claim 5 is nonobvious for at least the same reason.

Accordingly, it is respectfully requested that the rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Posner in view of Sevcik, in further view of Gindlesperger, be reconsidered and withdrawn.

The rejection of claims 11, 22 and 27 under 35 U.S.C. § 103(a), as being unpatentable over Posner in view of Sevcik, in further view of Huberman, is respectfully traversed based on the following.

Claim 11 depends from claim 1. As shown above, the combination of Posner and Sevcik fails to disclose or suggest calculating first and second estimated prices, informing the buyer of at least the lower of these estimated prices, and thereafter informing the printers of the set of specifications and the identity of the buyer, and therefore fails to render claim 1 obvious. As claim 11 depends from claim 1, claim 11 is likewise nonobvious over the combination of Posner and Sevcik for at least the same reason.

Forming the combination of Posner, Sevcik, and Huberman similarly fails to disclose or suggest calculating first and second estimated prices, informing the buyer of at least the lower of these estimated prices, and thereafter informing the printers of the set of specifications and the identity of the buyer. The Office Action cites to a portion of Huberman providing the buyer with the names of multiple printers, perhaps the three or four lowest bidders. As this is unrelated to calculating first and second estimated prices, informing the buyer of at least the lower of these estimated prices, and thereafter informing the printers of the set of specifications and the identity of the buyer, the cited portion of Huberman fails to disclose or suggest this limitation of claim 1. In sum, the cited combination of Posner, Sevcik, and Huberman fails to disclose or suggest all of the limitations of claim 1 and therefore cannot render claim 1 obvious. As claim 11 depends from nonobvious claim 1, claim 11 is nonobvious for at least the same reason.

Claims 22 and 27 depend, either directly or indirectly, from claim 21. As shown above, the combination of Posner, Sevcik, and Huberman fails to disclose calculating first and second price estimates, notifying the buyer of the lower of these price estimates, and thereafter informing at least one of the printers of the set of specifications and the identity of the buyer. Thus, the cited combination of Posner, Sevcik, and Huberman fails to render



obvious claim 21, which includes these limitations. As claims 22 and 27 depend from nonobvious claim 21, claims 22 and 27 are nonobvious for at least the same reason.

Accordingly, it is respectfully requested that the rejection of claims 11, 22 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Posner in view of Sevcik, in further view of Huberman, be reconsidered and withdrawn.

The rejection of claims 14-16 and 26 under 35 U.S.C. § 103(a), as being unpatentable over Posner in view of Sevcik, in further view of Anderson, is respectfully traversed based on the following.

Claims 14-16 depend, either directly or indirectly, from claim 1. As shown above, the combination of Posner and Sevcik fails to disclose or suggest calculating first and second estimated prices, informing the buyer of at least the lower of these estimated prices, and thereafter informing the printers of the set of specifications and the identity of the buyer, and therefore fails to render claim 1 obvious. Claims 14-16 are likewise nonobvious over the combination of Posner and Sevcik for at least the same reason.

Forming the combination of Posner, Sevcik, and Anderson similarly fails to disclose or suggest calculating first and second estimated prices, informing the buyer of at least the lower of these estimated prices, and thereafter informing the printers of the set of specifications and the identity of the buyer. The Office Action fails to cite to any portion of Anderson, but appears to relate to column 4, lines 48-53. This portion of Anderson discloses the collection of membership fees to prequalify an individual bidder. As this is unrelated to calculating first and second estimated prices, informing the buyer of at least the lower of these estimated prices, and thereafter informing the printers of the set of specifications and the identity of the buyer, this portion of Anderson fails to disclose or suggest this limitation of claim 1. In sum, the cited combination of Posner, Sevcik, and Anderson fails to disclose or suggest all of the limitations of claim 1 and therefore cannot render claim 1 obvious. As claims 14-16 depend from nonobvious claim 1, claims 14-16 are nonobvious for at least the same reason.

Claim 26 depends from claim 21. As shown above, the combination of Posner and Sevcik fails to disclose or suggest calculating first and second price estimates, notifying the buyer of the lower of these price estimates, and thereafter informing at least one of the printers of the set of specifications such that by contacting the buyer, the printer(s) negotiate the set of specifications, and therefore fails to render claim 21 obvious. Claim 26 is likewise nonobvious over the combination of Posner and Sevcik for at least the same reason.

Forming the combination of Posner, Sevcik, and Anderson similarly fails to disclose or suggest calculating first and second price estimates, notifying the buyer of the lower of these price estimates, and thereafter informing at least one of the printers of the set of specifications such that by contacting the buyer, the printer(s) negotiate the set of specifications. Anderson, at column 4, lines 48-53, discloses the collection of membership fees to prequalify an individual bidder. As this is unrelated to calculating first and second price estimates, notifying the buyer of the lower of these price estimates, and thereafter informing at least one of the printers of the set of specifications such that by contacting the buyer, the printer(s) negotiate the set of specifications, this portion of Anderson fails to disclose or suggest this limitation of claim 21. In sum, the cited combination of Posner, Sevcik, and Anderson fails to disclose or suggest all of the limitations of claim 21 and therefore cannot render claim 21 obvious. As claim 26 depends from nonobvious claim 21, claim 26 is nonobvious for at least the same reason.

Accordingly, it is respectfully requested that the rejection of claims 14-16 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Posner in view of Sevcik, in further view of Anderson, be reconsidered and withdrawn.

The rejection of claim 34 under 35 U.S.C. § 103(a), as being unpatentable over Sevcik in view of Posner, is respectfully traversed based on the following.

As shown above, the combination of Posner and Sevcik (or Sevcik and Posner) fails to disclose or suggest calculating first and second estimated prices, informing the

Application No. 09/836,691  
Amendment dated September 13, 2006  
Reply to Office Action of July 13, 2006

buyer of at least the lower of these estimated prices, and thereafter informing the printers of the set of specifications and the identity of the buyer. As each of these limitations is found in claim 34, the combination of Sevcik and Posner cannot render claim 34 obvious.

Accordingly, it is respectfully requested that the rejection of claim 34 under 35 U.S.C. § 103(a) as being unpatentable over Sevcik in view of Posner, be reconsidered and withdrawn.

### **CONCLUSION**

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin LLP Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee,

Application No. 09/836,691  
Amendment dated September 13, 2006  
Reply to Office Action of July 13, 2006

and not submitted herewith should be charged to Sidley Austin LLP Deposit Account  
No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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